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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/825,641	04/15/2004	Kevin Scott Smith	UNCC 02-020	9020

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EXAMINER

GATES, ERIC ANDREW

ART UNIT	PAPER NUMBER
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3722

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08/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,641	Applicant(s) SMITH ET AL.	
	Examiner Eric A. Gates	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9-11,13,14 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,7,9-11,13,14 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to Applicant's amendment filed on 14 June 2007.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Slocum et al. (U.S. Patent 6,280,126).
4. Regarding claim 1, Slocum et al. discloses an apparatus comprising: a first element 20 adapted to be coupled with a second element 50, the first element comprising a structured surface 29 and the second element comprising a second surface 52, wherein the second surface comprises a receiving surface 52 and wherein the structured surface comprises a plurality of depressions 21/26/27. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].
5. Regarding claim 3, Slocum et al. discloses wherein the receiving surface is substantially uniform (see figure 3).
6. Regarding claim 4, Slocum et al. discloses wherein the structured surface is adapted to be coupled with the receiving surface.

7. Regarding claim 10, Slocum et al. discloses wherein a viscous fluid is disposed on the structured surface (see column 4, lines 28-36).

8. Claims 1, 7, and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Najima et al. (U.S. Patent 5,143,493).

9. Regarding claim 1, Najima et al. discloses an apparatus comprising: a first element 1 adapted to be coupled with a second element 2, the first element comprising a structured surface 4 and the second element comprising a second surface 2, wherein the second surface 2 comprises a receiving surface 2 (surface 2 receives surface 4, see figure 2) and wherein the structured surface comprises a plurality of depressions 15. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

10. Regarding claim 7, Najima et al. discloses wherein the depressions 15 are substantially hemispherical.

11. Regarding claim 9, Najima et al. discloses wherein the structured surface 4 further comprises a projection 24.

12. Claims 1 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Karlsson et al. (WO 01/98008 A1).

13. Regarding claim 1, Karlsson et al. discloses an apparatus (see figure 11) comprising: a first element 11 adapted to be coupled with a second element 23b, the

first element comprising a structured surface 14/15 and the second element comprising a second surface 23b, wherein the second surface comprises a receiving surface 23b and wherein the structured surface comprises a plurality of depressions 14/15. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

14. Regarding claim 25, Karlsson et al. discloses wherein the depressions 14/15 are arranged in a non-uniform pattern (see figure 11).

15. Claims 11, 13, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Slocum et al. (U.S. Patent 6,280,126).

16. Regarding claim 11, Slocum et al. discloses an apparatus comprising: a first element 20 adapted to be coupled with a second element 40, the first element comprising a first surface 29; and means for damping 21/26/27, the damping means disposed on the first surface of the first element wherein the second element comprises a receiving surface 52 and wherein the damping means comprises a plurality of depressions 21/26/27 disposed in the first surface. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

17. Regarding claim 13, Slocum et al. discloses wherein the first surface is adapted to be coupled with the receiving surface.

18. Regarding claim 14, Slocum et al. discloses wherein the first surface is disposed adjacent to the receiving surface (see figures 2-5).

19. Claims 11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Najima et al. (U.S. Patent 5,143,493).

20. Regarding claim 11, Najima et al. discloses an apparatus comprising: a first element 1 adapted to be coupled with a second element 2, the first element comprising a first surface 4; and means for damping 15, the damping means disposed on the first surface of the first element wherein the second element comprises a receiving surface 2 and wherein the damping means comprises a plurality of depressions 15 disposed in the first surface. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

21. Regarding claim 16, Najima et al. discloses wherein the depressions 15 are substantially hemispherical.

22. Claims 17, 19, 20, 21, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Slocum et al. (U.S. Patent 6,280,126).

23. Regarding claim 17, Slocum et al. discloses a method of damping vibrations in a first element 20 and a second element 50, wherein said method comprises: adapting a first element to be coupled with a second element, the first element comprising a structured surface 29 and the second element comprising a second surface 52, the second surface comprising a receiving surface 52 and the structured surface comprising a plurality of depressions 21/26/27. While the disclosure does not distinctly state that

the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

24. Regarding claim 19, Slocum et al. discloses wherein the first surface is disposed adjacent to the receiving surface (see figure 2-5).

25. Regarding claim 20, Slocum et al. discloses wherein the first surface is adapted to be coupled with the receiving surface.

26. Regarding claim 21, Slocum et al. discloses disposing a viscous liquid on the structured surface (see column 4, lines 28-36).

27. Regarding claim 23, Slocum et al. discloses wherein the structured surface is engaged with the receiving surface.

28. Claims 17, 18, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Najima et al. (U.S. Patent 5,143,493).

29. Regarding claim 17, Najima et al. discloses a method of damping vibrations in a first element 1 and a second element 2, wherein said method comprises: adapting a first element 1 to be coupled with a second element 2, the first element comprising a structured surface 4 and the second element comprising a second surface 2, the second surface comprising a receiving surface 2 and the structured surface comprising a plurality of depressions 15. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

30. Regarding claim 18, Najima et al. discloses wherein the depressions 15 are substantially hemispherical.

31. Regarding claim 22, Najima et al. discloses wherein the structured surface 4 further comprises a projection 24.

32. Claims 17 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Karlsson et al. (WO 01/98008 A1).

33. Regarding claim 1, Karlsson et al. discloses a method of damping vibrations in a first element 11 and a second element 23b, wherein said method comprises: adapting a first element 11 to be coupled with a second element 23b, the first element comprising a structured surface 14/15 and the second element comprising a second surface 23b, the second surface comprising a receiving surface 23b and the structured surface comprising a plurality of depressions 14/15. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

34. Regarding claim 24, Karlsson et al. discloses wherein the depressions 14/15 are arranged in a non-uniform pattern.

35. Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by Slocum et al. (U.S. Patent 6,280,126).

36. Regarding claim 26, Slocum et al. discloses a damping apparatus 20/50 comprising: a first element 20 adapted to be coupled with a second element 50, the first

element comprising a structured surface 29 and the second element comprising a second surface 52, wherein the second surface comprises a receiving surface 52 and wherein the structured surface comprises a plurality of depressions 21/26/27. While the disclosure does not distinctly state that the depressions are formed by machining, this is being considered as a product-by process limitation. See MPEP 2113 [R-1].

Response to Arguments

37. Applicant's arguments filed 14 June 2007 have been fully considered but they are not persuasive.

38. Applicant's argument that Slocum refers to grooves or recesses, not depressions, is not persuasive because grooves and recesses fall under the standard definition for a depression. Merriam-Webster's Online Dictionary defines a "depression" as "a depressed place or part: hollow". The definition for "depressed" is "having the central part lower than the margin". The grooves/recesses of Slocum fall under these definitions.

39. Applicant's argument that Najima does not disclose a second surface comprising a receiving surface because this interpretation was applied and then the rejection removed is not persuasive because Najima has been reinterpreted in the current rejection, and a different surface has been identified as the second surface than was previously utilized.

40. For the reasons as set forth above, the rejections are maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric A. Gates whose telephone number is (571) 272-5498. The examiner can normally be reached on Mon-Thurs 8:45 - 6:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3722

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



EAG

21 August 2007



MONICA CARTER
SUPERVISORY PATENT EXAMINER